

REMARKS

Claims 1, 2, 4-6, 12, 13, 15-22 are pending in the present application. Claims 3, 7-11, and 14 are canceled; claims 1 and 12 are amended; and claims 18-22 are added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The examiner rejects claims 1, 2, 4, 5, 7, 8, 10, 12, 13, 15 and 17 under 35 U.S.C. § 102(b) as anticipated by *Nayak, Tape Media Cartridge System and Components Thereof and Methods of Making and Using the Same*, U.S. Patent 5,868,333 (Feb. 9, 1999) (hereinafter "*Nayak*"). This rejection is respectfully traversed.

The examiner believes that:

Nayak discloses a magnetic tape cartridge comprising a door 54 on a first face of the cartridge, a slider 66 on a second face of the cartridge adjacent the first face, a belt 68 connecting the door and the slider so that the door can be opened by movement of the slider, belt post 26 for guiding the belt so that it bends at an angle, and a torsion spring 72 that biases the door toward its closing position.

Office Action of January 7, 2005 (p.2).

Applicants have canceled claims 7-11, thereby rendering the rejections of those claims moot. Applicants have amended claims 1 and 12 to incorporate the limitations of claim 3. Claim 1 as amended provides:

1. A magnetic tape cartridge, comprising:
a door on a first face of the cartridge;
a slider on a second face of the cartridge;
a belt within the cartridge that connects the door and the slider;
wherein when the slider is moved, the door opens; and
wherein the door opens by sliding parallel to the first face.

The examiner admits, and Applicants agree, that *Nayak* does not show the feature of a door opening by sliding parallel to the first face. Thus, *Nayak* does not anticipate claim 1. For similar reasons, *Nayak* does not anticipate claim 12, which now contains limitations similar to those presented in claim 1.

In addition, contrary to the examiner's belief, *Nayak* does not show a belt within the cartridge as claimed. Instead, *Nayak* shows a cable connecting a tab and the rotating door. Thus, *Nayak* does not anticipate claims 1, 12, or 18 or any of their corresponding dependent claims.

Regarding claims 4, 10, and 21, contrary to the examiner's belief, *Nayak* does not show a post that bends the belt at an angle. Although the examiner cites reference numeral 26 of *Nayak* for the proposition that *Nayak* shows a post, *Nayak* describes reference numeral 26 as a cable guide member. See col. 4, l. 61, which states, "The cable 68 is routed along a cable guide member 26." The term "post" has a well-defined meaning to one of ordinary skill. A "cable guide member" does not have a well-defined ordinary meaning, though *Nayak* shows that the "cable guide member" is an arcuate projection within *Nayak*'s tape cartridge. The arcuate projection is not a post. Thus, *Nayak* does not anticipate claims 4, 10, and 21.

Applicants have successfully addressed the anticipation rejections. Therefore, the rejection of claims 1, 2, 4, 5, 7, 8, 10, 12, 13, 15 and 17 under 35 U.S.C. § 102(b) has been overcome.

The examiner rejects as obvious claims 3 and 14, the limitations of which are incorporated into claims 1 and 12, respectively. Thus, although claims 3 and 14 have been canceled, Applicants address the obviousness rejections vis-à-vis claims 1 and 12 below.

Furthermore, *Nayak* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Nayak* actually teaches away from the presently claimed invention because it teaches a space-wasteful pivoting door as opposed to a sliding door as in the presently claimed invention. Absent the examiner pointing out some teaching or incentive to implement *Nayak* and a sliding door, one of ordinary skill in the art would not be led to modify *Nayak* to reach the present invention when the reference is examined as a whole. As discussed below, *Ishihara* does not provide the necessary teaching or incentive to modify *Nayak*. Absent some teaching, suggestion, or incentive to modify *Nayak* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

II. 35 U.S.C. § 103, Obviousness

The examiner rejects claims 3, 6, 9, 11, 14 and 16 under 35 U.S.C. § 103(a) as obvious over *Nayak* in view of *Ishihara et al.*, Magnetic Tape Cartridge, U.S. Patent 6,435,439 (Aug. 20, 2002) (hereinafter "*Ishihara*"). This rejection is respectfully traversed.

The examiner believes that:

Nayak is described above. *Nayak* does not disclose that the door 54 opens by sliding parallel to the first face or that a compression spring provides force to close the door.

Ishihara et al teaches providing a tape cartridge 1 with a sliding door 27 that slides parallel to a face of the cartridge that includes an aperture closed by the door. *Ishihara et al* teaches providing the cartridge with a compression spring 10, 36 to provide a force to close the door.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide *Nayak* with a sliding door as taught by *Ishihara et al* to reduce the space required to open the door. It would have been obvious to provide *Nayak* with a compression spring as taught by *Ishihara et al* to provide the force for biasing the door to the closed position since it would have been apparent to an ordinary artisan that many different types of springs would be capable of providing the required closing force. Use of a compression spring allows for arrangement of parts to reduce the height (perpendicular to the large faces of the cartridge) of the door mechanism.

Office Action of January 7, 2005 (p.3).

Claims 9 and 11 have been canceled, thereby rendering the rejection moot with regard to those claims. Applicants have amended claims 1 and 12 incorporate the limitations of claims 3 and 14, respectively. Thus, Applicants address rejection of claims 3 and 14 even though these claims have been canceled. Claims 6 and 16 are non-obvious for the reasons provided below.

II.A The Examiner Has Failed to State a Prima Facie Obviousness Rejection of Claims 3 and 14.

A prima facie obviousness rejection of claims 3 and 14 has not been stated because a proper motivation to combine the references has not been stated. Regarding

claims 3 and 14, the examiner believes that, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide *Nayak* with a sliding door as taught by *Ishihara* et al to reduce the space required to open the door." However, *Nayak* has no need for saving space, as evidenced by the fact that the door pivots open. *Ishihara* never states or implies why *Ishihara* uses a sliding door. Thus, given that *Nayak* has no need to save space, one of ordinary skill would have no reason to combine or otherwise modify the references. Based on the plain disclosures in the references, the only suggestion to modify the references is found in Applicants' specification. Hence, the examiner must have used Applicants' specification to find a motivation to combine the references. Doing so is impermissible hindsight and fails to comport with the standards of Graham v. John Deere Co., 383 U.S. 1 (1966), which requires a proper motivation to combine or modify references to achieve a proper obviousness rejection. Accordingly, the examiner has failed to state a prima facie obviousness rejection of claims 3 and 14. For similar reasons, the stated rejection fails with regard to claims 1 and 12.

II.B Claims 3 and 14 Are Non-Obvious in View of *Nayak* and *Ishihara*

As shown above, *Nayak* has no need for a sliding door and *Ishihara* provides no reason to add a sliding door to *Nayak*. Thus, one of ordinary skill would have no need or motivation to combine *Nayak* and *Ishihara*. Accordingly, claims 3 and 14 are non-obvious. For similar reasons, claims 1 and 12 are also non-obvious.

In addition, *Ishihara* uses a spring to close the sliding door and an external actuator to open the sliding door. For this reason, *Ishihara* does not have any need or use for the belt shown in *Nayak*. Hence, one of ordinary skill again would not be motivated to combine the references. Thus, claims 3 and 14 are non-obvious. For similar reasons, claims 1 and 12 are non-obvious.

In addition, both *Nayak* and *Ishihara* represent complete solutions to the problems each solves. *Nayak* shows a device for opening pivot door in a tape cartridge. *Nayak* has no need to address the problem of saving space because *Nayak* provides an opening into which the pivoting door may be placed. Furthermore, *Nayak* provides no indication that saving space is a consideration in tape cartridges. On the other hand, *Ishihara* shows a device having a recess on the inner surface of a sliding door, thus *Ishihara* represents a

complete solution for opening and closing a sliding door. *Ishihara* provides no indication that saving space is a consideration in tape cartridges. Because each reference provides a complete solution to the problem that each reference represents and neither reference indicates that space should be saved in a tape cartridge, one of ordinary skill would have no reason to combine or otherwise modify the references. Accordingly, claims 3 and 14 are non-obvious. For similar reasons, claims 1 and 12 are non-obvious.

In addition, one of ordinary skill would not combine the references when the references are considered as a whole because the references are directed towards solving different problems. *Nayak* is directed to a mechanism for opening a pivot door in a tape cartridge. For example, *Nayak* provides:

Accordingly, it is an object of preferred embodiments of the present invention to provide an apparatus and process of making and using the same, for holding a single reel of tape media for use in compact computer tape drives, in which the cartridge aperture cover is detached from the tape media leader block.

Nayak, col. 1, l. 66 through col. 2, l. 4.

On the other hand, *Ishihara* is directed to use of a leader pin to stabilize the opening and closing of a door in a tape cartridge. For example, *Ishihara* provides as follows:

In accordance with the magnetic tape cartridge described above, by virtue of the recess formed on the inner surface of the sliding door at least at a part opposed to the lock member, interference of the lock member with the sliding door can be prevented and generation of failure in opening and closing the sliding door can be prevented. Further, freedom in the shape of the lock member is increased and the entrance portion of the lock member against which the leader pin is first brought into abutment can be gentle in inclination and sufficient in width, whereby leader pin holding action can be stabilized and reliability of the magnetic tape cartridge can be improved.

Ishihara, col. 2, l. 66 through col. 3, l. 10 (emphasis added).

Thus, the references address completely distinct problems in the art of storage tape cartridges. Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed inventions. Accordingly, claims 3 and 14 are non-obvious.

In addition, *Nayak* published in 1999. *Ishihara* published as a PCT Application in 1999. In the intervening six years, no one has produced a product that incorporates the claimed invention or has published a reference that shows the claimed invention. Given the value of the claimed invention, a value recognized by the examiner as a space-saving invention, if the claimed invention has been obvious then someone in the world would have already shown or suggested the claimed invention. Because no one has shown or suggested the claimed invention in the intervening six years, claims 3 and 14 are non-obvious. For similar reasons, claims 1 and 12 are non-obvious.

Similarly, in the intervening six years only Applicants have proposed the claimed invention and only the examiner has suggested combining the references. Thus, again, the examiner must have used impermissible hindsight when fashioning the obviousness rejections. Accordingly, the examiner has failed to state *prima facie* obviousness rejections of claims 3 and 14. For similar reasons, the current rejection fails against claims 1 and 12.

II.C The Examiner Has Failed to State a Prima Facie Obviousness Rejection of Claims 6 and 16.

The examiner has failed to state a *prima facie* obviousness rejection of claims 6 and 16 because the proposed combination does not result in the claimed inventions. The examiner believes that, "*Ishihara et al* teaches providing the cartridge with a compression spring 10, 36 to provide a force to close the door," and that:

It would have been obvious to provide *Nayak* with a compression spring as taught by *Ishihara et al* to provide the force for biasing the door to the closed position since it would have been apparent to an ordinary artisan that many different types of springs would be capable of providing the required closing force. Use of a compression spring allows for arrangement of parts to reduce the height (perpendicular to the large faces of the cartridge) of the door mechanism.

The examiner also notes that *Nayak* shows a torsion spring 72 used to urge the pivot door closed. However, *Nayak* does not show a compression spring as being part of the cartridge. *Nayak* does show a compression spring as part of the cartridge opener, reference numeral 106 in Figure 9, though *Nayak* does not show a compression spring

within the cartridge itself and would not benefit from a compression spring within the cartridge itself. On the other hand, *Ishihara* shows a compression spring used to close a sliding door. However, the compression spring would be of no use in closing *Nayak*'s pivoting door. Thus, the proposed combination would be inoperable and would not result in the claimed inventions. Accordingly, the examiner has failed to state a prima facie obviousness rejection of claims 6 and 16.

Even if both the compression spring and sliding door of *Ishihara* were incorporated into *Nayak*'s device, the proposed combination would still fail to result in the claimed inventions. *Nayak* teaches placing the spring at the location of the door, as does *Ishihara*. Even if *Nayak*'s pivoting door were replaced with a sliding door, the compression spring would be useless at the location of the door because *Nayak*'s cable eliminates the need for the compression spring. Thus, the proposed combination would be useless and would not result in the claimed inventions. Accordingly, the examiner has failed to state a prima facie obviousness rejection of claims 6 and 16.

In addition, a prima facie obviousness rejection has not been stated because a proper motivation to combine the references has not been stated. As shown above, no reason exists to combine the compression spring of *Ishihara* with the device shown in *Nayak*. Even if Applicants admit that urging the door closed is desirable, *Nayak* accomplishes that goal through the use of the cable and a torsion spring. The compression spring would not help in *Nayak*'s device because the cable would interfere with the operation of the compression spring. Thus, the above statement lacks sufficient detail to provide a proper motivation to combine the references. Accordingly, the above statement can not be a proper motivation to combine the references.

Furthermore, the examiner has provided no reason why one of ordinary skill would recognize that reducing the height of the door mechanism would be desirable. As shown above, the references themselves provide no indication that doing so is desirable; only Applicants indicate that doing so is desirable. Thus, the examiner must have used impermissible hindsight when fashioning the obviousness rejections. Accordingly, the examiner has failed to state a prima facie obviousness rejection of claims 6 and 16.

In addition, even if one of ordinary skill recognizes that many different types of springs are available, the examiner must provide a motivation why one of ordinary skill

would implement a particular type of spring. As shown above, the use of a compression spring in the cartridge of *Nayak* would be either inoperable or useless, even if the sliding door were included. This example shows why the statement offered by the examiner cannot be used as a substitute for the requirement under Graham v. John Deere that a proper motivation be present to combine the references. Accordingly, the above statement can not be a proper motivation to combine the references.

Because the examiner has not provided a proper motivation to combine the references, the examiner has failed to state a prima facie obviousness rejection of claims 6 and 16. Accordingly, Applicants request that the rejection be withdrawn.

II.D Claims 6 and 16 Are Non-Obvious in View of *Nayak* and *Ishihara*

Claims 6 and 16 depend from newly amended claims 1 and 12, respectively. Thus, claims 6 and 16 should be patentable over *Nayak* and *Ishihara* for the reasons stated above.

In addition, as shown above, *Nayak* has no need for a compression spring and *Ishihara* provides no reason to add a compression spring to the cartridge shown in *Nayak*. Thus, one of ordinary skill would have no need or motivation to combine *Nayak* and *Ishihara*. Accordingly, claims 6 and 16 are non-obvious.

In addition, as shown above, the references address completely distinct problems in the art of storage tape cartridges. Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed inventions. Accordingly, claims 6 and 16 are non-obvious.

In addition, *Nayak* published in 1999. *Ishihara* published as a PCT Application in 1999. In the intervening six years, no one has produced a product that incorporates the claimed invention or published a reference that shows the claimed invention. Given the value of the claimed invention, a value recognized by the examiner as a space-saving invention, if the claimed invention has been obvious then someone in the world would have already shown or suggested the claimed invention. Because no one has shown or suggested the claimed invention in the intervening six years, claims 6 and 16 are non-obvious.

Similarly, in the intervening six years only Applicants have proposed the claimed invention and only the examiner has suggested combining the references. Given the failure of everyone in the world to show or suggest the claimed inventions, other than Applicants, the examiner must have used impermissible hindsight when fashioning the obviousness rejections. Accordingly, the examiner has failed to state prima facie obviousness rejections of claims 6 and 16.

II.E Summary of Non-Obviousness of Claims 1, 6, 12, and 16

The examiner failed to state prima facie obviousness rejections of claims 3 (now claim 1), 6, 14 (now claim 12), and 16 because the examiner did not state proper motivations to combine the references. Furthermore, with respect to claims 6 and 16, the examiner failed to state prima facie obviousness rejections because the proposed combination does not result in the claimed inventions.

In addition, claims 1, 6, 12, and 16 are non-obvious in view of the references because no motivation exists to combine the references. *Nayak* would not benefit from the inclusion of a sliding door or a compression spring. In addition, *Nayak* and *Ishihara* represent complete solutions to the problems that each solves; thus, no one would be motivated to combine the references. Had the claims been obvious then, given the value of the claimed inventions, someone would have shown or suggested the claimed inventions in the intervening six years. Accordingly, the claims are non-obvious in view of the cited references. Therefore, the rejection of claims 3 (now claim 1), 6, 14 (now claim 12) and 16 under 35 U.S.C. § 103(a) has been overcome.

III. New Claim 18

Regarding new claim 18, new claim 18 includes a feature in which a compression spring is used in conjunction with the door. New claim 18 provides as follows:

18. A magnetic tape cartridge, comprising:
a door on a first face of the cartridge;
a slider on a second face of the cartridge;
a belt within the cartridge that connects the door and the slider;
wherein when the slider is moved, the door opens; and

a compression spring, wherein the compression spring provides force to close the door.

The examiner admits, and Applicants agree, that *Nayak* does not show the feature of magnetic tape cartridge having a compression spring providing force to urge the door closed. Thus, *Nayak* does not anticipate new claim 18. For similar reasons, *Nayak* does not anticipate new claims 19-22 by virtue of their dependency on claim 18.

In addition, as shown above, a combination of *Nayak* and *Nishihara* would not result in the inventions of claims 18-22. Furthermore, also as shown above, *Nayak* has no need for a compression spring and *Ishihara* provides no reason to add a compression spring to the cartridge shown in *Nayak*. Thus, one of ordinary skill would have no need or motivation to combine *Nayak* and *Ishihara*. In addition, as shown above, the references address different problems and had the references been obvious then one of ordinary skill would have already disclosed the claimed inventions. For the foregoing reasons, claims 18-22 are non-obvious in view of the references when the references are considered as a whole.

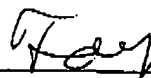
IV. Conclusion

It is respectfully urged that the subject application is patentable over *Nayak* and *Ishihara* and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: May 6, 2005

Respectfully submitted,



Theodore D. Fay, III
Reg. No. 48,504
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicants